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OFFICE OF PETITIONS

In re Patent of Usala : DECISION ON REQUEST
Patent No. 7,700,660 : FOR
Issue Date: April 20, 2010 : RECONSIDERATION OF
Application No. 09/870,414 : PATENT TERM ADJUSTMENT
Filed: May 30, 2001 : and
Atty Docket No. 35626/234825 : NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the petition filed on April 23, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by two thousand one hundred twenty-five (2125) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by two thousand one hundred twenty-five (2125) days is **GRANTED to the extent indicated herein.**

Patentee asserts the period of delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") is 1147 days. The Office finds the period of A Delay is 1039 days. The Office and patentee agree that an adjustment of 462 days is warranted for the Office's delay in issuing a first Office action within 14 months of the filing date of the application, pursuant to 37 CFR 1.702(a)(1). However, patentee contends the Office should be charged with a 685 day delay under 37 CFR 1.702(a)(2) for failing to respond to applicant's appeal brief within 4 months of the filing date of the appeal brief on March 14, 2006. Currently, the Office is charged with a 152 day delay under 37 CFR 1.702(a)(2) for failing to respond to applicant's appeal brief within 4 months of the filing date of the appeal brief on March 14, 2006. Patentee calculates this 685 day period from July 14, 2006, the date four months after applicant filed his first appeal brief,

to May 29, 2008, the date the Office mailed a non-final Office action.

35 U.S.C. 154(b)(1)(A) provides, in pertinent part, that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to -

...

(ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

37 CFR 1.702(a) provides, in pertinent part that subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

However, as provided in 37 CFR 1.703(a), this period is calculated as:

(4) The number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 41.37 of this title was filed and ending on the date of mailing of any of an examiner's answer under § 41.39 of this title, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

Furthermore, as stated in the Final Rule¹,

Section 1.703(a)(4) also pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(ii). Section 1.703(a)(4) specifies that the period is the number of days, if any, beginning on the day after the date that is four months after the date an appeal brief in compliance with 1.192 was filed and ending on the mailing date of any of an examiner's answer under 1.193, an

¹ See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 56366 (September 18, 2000).

action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first. As discussed below, the phrase "the date on which" an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii) means the date on which an appeal brief (and not a notice of appeal) was filed. The phrase "appeal brief in compliance with 1.192" requires that: (1) the appeal brief fee (1.17(c)) be paid (1.192(a)); and (2) the appeal brief complies with 1.192(c)(1) through (c)(9). (See also the Response to Comment 38).

In this instance, an appeal brief *in compliance with 1.192* was filed on June 30, 2006 and the Office took action in response on May 29, 2008 by mailing a non-final Office action. Accordingly, a period of adjustment of 577 days associated with the mailing of the May 29, 2008 non-final Office action is warranted. This period begins on October 31, 2006, the day after four months after an appeal brief *in compliance with 1.192* was filed, and ends on May 29, 2008, when the non-final Office action was mailed.

The period of adjustment of 152 days is being removed and a period of adjustment of 577 days is being entered in connection with the mailing of the non-final Office action on May 29, 2008 after the filing of a compliant appeal brief on June 30, 2006.

Patentee correctly calculates the maximum period of delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") as 2151 days, beginning on May 31, 2004 and ending on April 20, 2010. However, patentee does not correctly calculate the excluded appellate period. The provisions of 37 C.F.R. § 1.703(b)(4) implement 35 U.S.C. § 154(b)(1)(B)(ii). Pursuant to 37 C.F.R. § 1.703(b)(4), the period of B Delay does not include,

The number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 41.31 of this title and ending on the date of the last decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145, or on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first, if the appeal did not result in a decision by the Board of Patent Appeals and Interferences.

Excluding the 928 days consumed by appellate review pursuant to 35 U.S.C. 154(b)(1)(B)(ii), beginning on the date a notice of appeal was filed, November 14, 2005, and ending on the date a non-final Office action was mailed, May 29, 2008, the period of B delay is 1223 days (2151 - 928).

In view of the above, the correct patent term adjustment is **two thousand sixteen (2016) days** (1039 days A Delay minus 2151 days maximum B Delay minus 928 excluded days minus 246 days Applicant Delay).

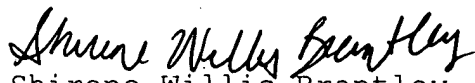
The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentee is given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **two thousand sixteen (2016) days**.

Telephone inquiries should be directed to the undersigned at (571) 272-3230.


Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,700,660 B2

DATED : April 20, 2010

DRAFT

INVENTOR(S) : Usala

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 1592 days

Delete the phrase "by 1592 days" and insert – by 2016 days--